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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92052150
Party	Plaintiff Wonderbread 5
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 3691948 for the Word Mark WONDERBREAD 5
(Registered on October 6, 2009)

WONDERBREAD 5,

Petitioner,

v.

PATRICK GILLES,

Registrant.

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) Cancellation No. 92052150
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**PETITIONER'S OPPOSITION TO REGISTRANT'S RULE 56(f) MOTION FOR
DISCOVERY**

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Petitioner Wonderbread 5 ("Petitioner" or the "Band"), a musical group and a California general partnership, seeks cancellation of Registration Number 3691948 for the Word Mark WONDERBREAD 5 (the "mark"). The Registration was obtained by Patrick Gilles ("Registrant"), a former Band member, without the knowledge or consent of the Band, which – as Registrant knew – intended to continue using the name "Wonderbread 5," and did in fact continue using the name in commerce. As such, the Band sought cancellation on the grounds that (1) the mark is likely to be confused with a mark previously used and not abandoned by Petitioner; and (2) the Registration was fraudulently procured. On July 30, 2010, the Band moved for a judgment on the pleadings, or alternatively for summary judgment, on its Petition for Cancellation.

Rather than respond to the merits of Petitioner's motion, Registrant filed a motion for discovery pursuant to Federal Rule of Civil Procedure 56(f). Registrant cannot make the requisite showing that the discovery he seeks is essential to his ability to oppose Petitioner's motion for judgment. *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 1387 (Fed. Cir. 1989) (allegation in affidavit that necessary evidence existed but was in moving party's possession insufficient).

The discovery Registrant seeks cannot create a genuine issue of material fact. Moreover, much of the information he claims he must obtain before responding to Petitioner's motion is already in his possession. There is no reason to prolong this litigation, wasting the resources of both the Board and the parties. Registrant's motion should be denied in full, and proceedings on Petitioner's motion for summary judgment should go forward.

I. INTRODUCTION

In his Rule 56(f) motion, Registrant concedes that no discovery is necessary on the issue of whether he committed fraud upon the USPTO by declaring, under penalty of perjury, in his March 12, 2009 trademark application that “no other person, firm, corporation, or association has the right to use the mark in commerce...” Plaintiff’s Rule 56(f) Motion for Discovery (“Motion”) at p. 3. Registrant’s motion rests solely on the claim that he cannot respond to Petitioner’s motion for summary judgment without discovery on the issue of whether “Registrant retains no rights in the trademark WONDERBREAD 5 because he sold all interest in the mark to the Petitioner as a part of a settlement of a prior lawsuit filed in San Francisco Superior Court.” *Id.*

Registrant either fundamentally misunderstands or deliberately mischaracterizes the first ground for the Petition for Cancellation, *i.e.*, that the mark Registrant claims to own is identical to the mark previously used and not abandoned by the Band. The issue is *not* whether Registrant “sold” his interest in the mark in connection with the settlement of his state court suit. Rather, the issues raised by the Petition and the motion for judgment are whether the Registration must be cancelled because *all* of Registrant’s use of the mark prior to his departure from the Band was as a member of the Band, whether the Band owned the rights to the mark through prior use, and whether the Band abandoned the mark. *See* Petition, ¶ 5 (“In light of the Band’s continuous use in commerce of the name WONDERBREAD 5 and the fact that it is universally known by that name, the Band is the rightful owner of the WONDERBREAD 5 mark...”)).

Settled law and undisputable evidence mandate that the Registration be cancelled. Because no amount of discovery can avoid that conclusion, Registrant’s motion must be denied. None of the discovery Registrant seeks can raise a triable issue as to whether the Band’s use of an identical mark predates any use by Registrant individually, or as to whether the Band

abandoned its use of the mark. Moreover, Registrant is bound by the admissions he made in the civil suit against the Band and cannot attempt to create sham fact issues by conducting discovery in hopes of finding evidence that contradicts his own admissions. Finally, Registrant already possesses much of the information he claims he requires to respond to the merits of Petitioner's motion for judgment. As such, there is no basis for further delaying decision on Petitioner's motion.

II. STATEMENT OF FACTS

The relevant facts have been set forth in the Petition for Cancellation, as well as in Petitioner's motion for judgment. As pertinent here, the facts are as follows:

Days after he was terminated from the Band, without the Band's knowledge or consent, Registrant filed an application for registration of the mark in connection with "[e]ntertainment services in the nature of live musical performances." Petition, ¶ 7, Ex. A. He filed the application as an individual (as opposed to as a member of a general partnership or other entity.) *Id.*

Shortly thereafter, Registrant filed a Complaint against the Band, its individual members, and its agent and manager in San Francisco Superior Court, alleging various causes of action, all in connection with Registrant's involvement with the Band. Petition, ¶ 8, Ex. B ("Complaint").

In the Complaint, Registrant admitted the following facts, about which he now contends he must conduct discovery:

- Wonderbread 5 "is a California General Partnership, either formally or ostensibly, that was formed in 1996 and that all times herein mentioned was and is doing business in California." Complaint, ¶ 11;

- “[I]t was [Band member John] McDill, Plaintiff believes who suggested ‘Wonderbread’ ... Shortly thereafter, the number 5 was appended to ‘Wonderbread’ and the Band members all agreed on the name ‘Wonderbread 5.’” Complaint, ¶ 24;
- “The Band’s first live performance was on a Thursday evening in November 1996.” Complaint, ¶ 25;
- “The Band was a long-standing institution in the Bay Area and abroad with shows booked out a year in advance. WB5 had performed in over 12 states and 3 foreign countries with private engagements booked for Mexico, Puerto Rico and Canada.” Complaint, ¶ 26;
- “On Tuesday, March 10, 2009 ... [Band member Christopher] Adams advised Plaintiff that ... ‘you’re out of the Band.’” Complaint, ¶¶ 78-79;
- “On Thursday, March 12, 2009, Plaintiff received an email letter from Barry Simons, a lawyer, on behalf of the members of the Band advising Plaintiff that Plaintiff was no longer a member of the Band and that the Band ‘shall continue to perform and conduct business under the name ‘Wonderbread 5.’” Complaint, ¶ 85;
- “Plaintiff, through counsel, issued two demands to WB5 and its individual partners ... for an accounting and copies of the books and records of the partnership business ... and requesting a buyout.” Complaint, ¶ 91.

Registrant made similar admissions in his sworn deposition. For instance, he testified that the allegations in his Complaint regarding the creation of the Band name were accurate. Counsel Declaration in Opposition to Registrant’s Rule 56(f) Motion (“Counsel Decl.”), Ex A at pp. 48-49. He further testified regarding his actual knowledge that the Band intended to, and in

fact did, continue performing under the name “Wonderbread 5” and otherwise using the mark in commerce after he was terminated. *Id.* at pp. 79-80, 144, 147, 186-87.

In sum, Registrant admitted in the state court proceedings that the Band is a general partnership, that the Band created and operated under the WONDERBREAD 5 mark and used the mark in interstate commerce, that Registrant was fired from the Band on or about March 10, 2009, that he knew the Band intended to continue using the Mark, and that he expected to be bought out of his partnership interest in the Band. (The lawsuit ultimately settled when Registrant accepted Defendants’ Offer to Compromise, in which the Band offered to buy out his interest in the Band in exchange for a release of *all* claims in and to the Band. Counsel Declaration in Support of Petition for Cancellation (“Pet. Counsel Decl.”), ¶¶ 4-7, Exs. B-D.)

III. REGISTRANT’S REQUESTED DISCOVERY

Registrant claims that the discovery he has requested is focused on material facts necessary for him to oppose Petitioner’s motion for judgment. However, inspection of the requests belies his claim. His (often redundant) discovery requests seek information Registrant already possesses, and they seek evidence that cannot possibly create a genuine dispute of material fact.

A. Information Regarding Whether the Band is a General Partnership

Several of Registrant’s discovery requests apparently seek information contradicting Petitioner’s assertion that it is a general partnership, though he never explains how evidence that the Band is not a general partnership could create a triable issue of material fact; nor does he acknowledge his prior admission that the Band is a general partnership.

Request for Production No. 12: Any and all Documents evidencing that the band Wonderbread 5 operated as a general partnership as claimed in the Petition to Cancel.

Interrogatory No. 12: Identify all persons or parties, past and present, that are or were members of the band Wonderbread 5, state the dates of their membership in the band and whether said membership was memorialized in any writing, documents, or otherwise.

Interrogatory No. 13: Describe in detail any partnership agreement that existed between Registrant and Petitioner or any other party with regard to the band Wonderbread 5.

Interrogatory No. 14: Identify all persons or parties, past and present, that were part of any partnership agreement with regard to the band Wonderbread 5.

B. Information Regarding the Selection of the Band Name

Registrant seeks to propound several discovery requests pertaining to who created or selected the Band name Wonderbread 5 and how the name was adopted by the Band. Such information is irrelevant for at least two reasons. First, the undisputed evidence, including Registrant's own admissions (*see, e.g.*, Counsel Decl., Ex. A at pp. 48-49), demonstrates that Registrant did not create the Band name, and that he did not use the name in commerce before the Band began doing so. Second, the person or entity that first used the mark in commerce – not the person or entity that conceived of the mark – owns the mark. *E.g., Combined Oil Indus., Ltd. v. Oil Master, Inc.*, 209 U.S.P.Q. 646 (N.D. Ill. 1980).

Request for Production No. 1: All Documents evidencing, referring, or relating to the selection or adoption by Petitioner of Petitioner's Claimed Mark.

Request for Production No. 2: Documents sufficient to identify each Person who participated or was involved in the selection of Petitioner's Claimed Mark, and with respect to each Person so identified, the nature and scope of his or her involvement.

Request for Production No. 13: Any and all Documents pertaining to the creation and/or selection of the band name Wonderbread 5.

Interrogatory No. 2: Identify each person who has knowledge of petitioner's selection and adoption of Petitioner's Claimed Mark and who has knowledge of how it is used and how it is intended to be used.

Interrogatory No. 11: Identify all persons who have knowledge concerning Petitioner's selection, adoption and/or use of Petitioner's Claimed Mark for any products and services and provide a summary of each person's knowledge.

Interrogatory No. 15: Describe in detail the process during which the name of the band "Wonderbread 5" was selected.

Interrogatory No. 16: Identify any persons or parties present during the conception and/or selection of the band name "Wonderbread 5," including, but not limited to, how the name was created, how the name was chosen to be the name of the band, the names of the band members at the time of the selection of the name and who Petitioner contends owned or controlled the name at the time of its adoption.

C. Information Regarding the Band's Ownership and Use of the Mark

Registrant likewise seeks information regarding Petitioner's ownership and use of the WONDERBREAD 5 mark since the Band's inception in 1996. In addition to being immaterial to the issues raised in the Petition and the motion for judgment, Registrant already has knowledge of the facts he seeks, by virtue of his membership in the Band from 1996 through 2009.

Interrogatory No. 3: Describe in detail all goods and services formerly and currently being offered by Petitioner in conjunction with Petitioner's Claimed Mark, identify the dates on which Petitioner first began such use(s), the geographic areas in which such use occurred, and the individuals who provided those services.

Interrogatory No. 6: With respect to each good and/or service identified in your response to Interrogatory No. 3, describe in detail the manner in which Petitioner's Claimed Mark is promoted in the United States, including but not limited to the media and mode of any marketing efforts as well as the geographic regions in which said promotions are conducted. Further identify who has been responsible for the promotion of Petitioner's Claimed Mark from the alleged date of first use to the present.

Interrogatory No. 8: Identify the person or persons who, from the date of Petitioner's claimed first use(s) of Petitioner's Claimed Mark to the present, have been responsible for the marketing and/or promotion of Petitioner's goods and services under Petitioner's Claimed Mark indicating the period during which each person was so responsible.

Interrogatory No. 19: Describe in detail any agreement regarding ownership of the rights of the mark WONDERBREAD 5.

Interrogatory No. 20: Identify those individuals or the entity you contend owns the subject mark WONDERBREAD 5 from the date of first use to the present specifically indicating the original owner(s) or entity [sic] of the mark, any changes in ownership

which have occurred, and who or what entity you contend currently owns the mark and why.

D. Information Regarding Prior Adversarial Proceedings and the Settlement of the State Court Lawsuit

Finally, Registrant requests information pertaining to prior litigation involving the Band, particularly the state court proceeding *in which he was the plaintiff*.

Request for Production No. 6: A copy of any document purporting to convey, sell, and/or release Registrant's ownership and control of Registrant's Mark WONDERBREAD 5 to any party, entity, or otherwise.

Request for Production No. 7: A copy of the letter Document from Mr. David M. Given to Douglas B. Wroan dated September 15, 2009 which states in part "as previously discussed, the band has no assets (known), liabilities (and therefore no liquidation value), and no balance sheet or income statement available."

Interrogatory No. 10: Describe in detail any adversarial proceeding, challenge, or litigation involving Petitioner's Claimed Mark, Registrant's membership in Petitioner, or Registrant's ownership of the mark at issue, including the claims, defenses, and a description of the resolution thereof.

Interrogatory No. 17: Describe in detail the civil litigation dispute between Registrant and Petitioner, including the details of any settlement agreement between Registrant and Petitioner.

Interrogatory No. 18: Identify any and all persons and/or parties who signed any settlement agreement for the civil litigation dispute referenced in Interrogatory No. 17.

IV. ARGUMENT

A. Legal Standard

A motion for discovery pursuant to Rule 56(f) is appropriate only where a party cannot effectively oppose a motion for summary judgment without taking discovery. *See also* TBMP Rule 528.06. Only where the party has demonstrated a need for discovery that is reasonably directed to obtaining facts *essential* to its opposition will discovery be permitted. *Id.* Where the information sought is already largely within the control of the nonmoving party, the discovery is likely unnecessary. *Cf. Orion Group Inc. v. Orion Ins. Co.*, 12 U.S.P.Q.2d 1923 (TTAB 1989).

The party seeking discovery must state why he is unable to present facts to show the existence of a genuine issue of material fact; conclusory affidavits that do not set forth the legal theories asserted by the nonmoving party, and how the facts sought support those theories, are insufficient. *Keebler, supra*, 866 F.2d at 1389 (denying Rule 56(f) motion based on affidavit that essentially failed to “say[] anything more than, ‘we have no factual basis for opposing summary judgment, but, if you stay proceedings, we might find something.’ ... Rule 56(f) requires an affiant to *state reasons* why he cannot present by affidavit facts essential to justify his opposition to the motion for summary judgment.”) (emphasis in original). *See also Burlington Coat Factory Warehouse Corp. v. Esprit De Corp.*, 769 F.2d 919, 926 (2d Cir. 1985) (affidavit must show what facts are sought and how they are reasonably expected to create a genuine issue of material fact).

A fact is material only where it may affect the ultimate decision, and where the finding of fact is necessary to the proceedings. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A dispute is genuine only where, considering the record as a whole, a reasonable fact finder could resolve the factual issue in favor of the nonmoving party. *Id.* Entry of summary judgment cannot be delayed to permit discovery on factual issues that the moving party has already negated. *Volk v. D.A. Davidson & Co.*, 816 F.2d 1406, 1416 (9th Cir. 1987). *Accord Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1566 (Fed. Cir. 1987) (“Summary judgment need not be denied merely to satisfy a litigant’s speculative hope of finding some evidence [through discovery] that might tend to support [the nonmoving party’s position].”). Finally, where permitting discovery would have no effect other than to “put the parties to unnecessary expense” and “waste[] judicial resources,” a Rule 56(f) motion must be denied. *Sweats Fashions*, 833 F.2d at 1567.

B. Registrant's Brief and Affidavit Fail to State Specific, Valid Reasons Why Discovery is Needed

Registrant's brief and affidavit in support of his Rule 56(f) motion include precisely the type of conclusory claims of entitlement to discovery that are insufficient as a matter of law, as held in cases such as *Keebler, supra*. As such, his motion must be denied.

1. Registrant's Arguments Regarding a Purported "Sale" of His Rights to the Mark Are Misguided

The only clear statements in Registrant's motion and supporting papers attempting to explain why discovery is necessary reflect a fundamental misunderstanding of the basis of the Petition for Cancellation. Arguments relying on such a misunderstanding cannot justify further delaying a ruling on Petitioner's motion for judgment.

Registrant asserts that the issues in this case are "(1) [whether Petitioner] owned rights to the mark WONDERBREAD 5 as of September 3, 2009 and October 1, 2010 [sic], the respective relevant dates for Defendant's Offer to Compromise, (2) [whether] the underlying lawsuit dealt with or otherwise affected trademark rights in the mark WONDERBREAD 5, and (3) [whether] Registrant, in executing Defendant's Offer to Compromise intended to transfer all rights in the mark WONDERBREAD 5 to Registrant." Motion at p. 4. Relying on these purported issues, Registrant's *only* claim to a need for discovery is to obtain "any and all agreements, information, or otherwise between Petitioner and Registrant that would establish the above three assumptions." *Id.*

Registrant apparently believes that he can overcome Petitioner's motion for summary judgment if only he can force Petitioner to state on the record that no agreement exists whereby Registrant "sold" his rights in the mark to Petitioner. *See* Motion at pp. 3-4. But as a matter of law, upon a member's departure from a band, the band's name and trademark remain with the band and do not transfer to the leaving member. *Robi v. Reed*, 173 F.3d 736, 740 (9th Cir. 1999)

("members of a group do not retain rights to use the group's name when they leave the group ... when [band member] left the group, *he took no rights to the service mark with him*") (emphasis added). *See also Kingsmen v. K-Tel Int'l, Ltd.*, 557 F. Supp. 178 (S.D.N.Y. 1983) (holding that former lead singer of a musical group did not have the right to use the group's name after his departure from the group); *Giammarese v. Delfino*, 197 U.S.P.Q. 162, 163 (N.D. Ill. 1977) (former band member enjoined from performing under band name). Although an individual dissociating from a general partnership may have a right to have his interest in the assets of the partnership bought out (*see* Cal. Corp. Code 16701), such a buy-out does not constitute the sale of any intellectual property; ownership of intellectual property remains with the partnership. *Cf. Bell v. Streetwise Records, Ltd.*, 761 F.2d 67 (1st Cir. 1985) (trademark is not divisible property and therefore cannot be owned separately by one member of a joint venture); *Cesare v. Work*, 520 N.E.2d 586 (Ohio App. 1987) (name of music group was not personal to the performers, but identified and distinguished a style and rendition of music; departing members had no right to use of name).

Consequently, when Registrant was terminated from the Band on March 10, 2010, he no longer possessed any right to use the Band's name, which remained with the Band. His attempts to attribute to Petitioner the implausible claim that the buy-out (*i.e.*, the Offer to Compromise) constituted the sale of the mark by Registrant to Petitioner are unavailing. *Registrant never owned the mark, so he had nothing to sell.* Registrant could propound no discovery regarding the settlement of his state court lawsuit that could enable him to refute Petitioner's well-founded claim that the Registration must be cancelled due to Petitioner's prior use in commerce of an identical mark.

2. Registrant Stated No Reasons Why Discovery is Needed Regarding the Band's Status as a General Partnership, the Selection of the Band Name, or the Band's Use of the Mark

Nowhere in Registrant's affidavit – largely a verbatim restatement of the arguments in the brief – does he even attempt to explain why he needs information pertaining to the Band's status as a general partnership, the selection of the Band name, or the Band's use of the mark. Rather than setting forth how the facts he seeks could create a genuine issue of material fact, he simply asserts that "Registrant cannot effectively respond to the instant motion concerning Petitioner's alleged rights in the mark WONDERBREAD 5 as well as what, if any rights of Registrant were transferred to Petitioner through Defendant's Offer to Compromise in the absence of answers and responses to Registrant's discovery..." Affidavit, ¶ 10. The affidavit is manifestly insufficient. *Keebler*, 866 F.2d at 1389 (denying Rule 56(f) motion based on affidavit that essentially failed to "say[] anything more than, 'we have no factual basis for opposing summary judgment, but, if you stay proceedings, we might find something.'"); *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1566 (Fed. Cir. 1987) ("Summary judgment need not be denied merely to satisfy a litigant's speculative hope of finding some evidence [through discovery] that might tend to support [the nonmoving party's position].").

C. The Discovery Registrant Seeks Cannot Create a Genuine Issue of Material Fact

1. Because Registrant is Bound by his Prior Admissions, Efforts to Obtain Evidence to Refute Them Are Futile

As set forth in Petitioner's motion for judgment, where a party to a prior legal action obtained a settlement or judgment, that party cannot assert a contradictory position in a subsequent action against the same counter party. *See Franks v. Nimmo*, 796 F.2d 1230, 1236-37 (8th Cir. 1990) (affidavit submitted in opposition to motion for summary judgment attempting to

create a “sham fact issue” by contradicting prior admissions was disregarded by court). Rather, under the principal of judicial estoppel, the pleadings and other representations to the court in the first action are binding in subsequent suits, and attempts by the party to refute his earlier admissions cannot overcome a motion for judgment on the pleadings, or for summary judgment. *E.g., Scarano v. Cent. R.R. Co. of N. J.*, 203 F.2d 510 (3d Cir. 1953) (defendant’s motion for summary judgment against plaintiff seeking reinstatement to his job was granted because plaintiff was estopped from contradicting his claim in prior proceeding that he was permanently disabled from performing his job duties). *Accord In re Cassidy*, 892 F.2d 637 (7th Cir. 1990); *Matamoros v. Tort Claims Trust*, 1999 WL 24612 (E.D. La. Jan. 15, 1999).

Just as the Registrant is estopped from offering evidence and arguments contradicting admissions he made in the state court proceeding because to do so “would most flagrantly exemplify ... playing fast and loose with the courts,” *Scarano*, 203 F.2d at 513, he must also be estopped from conducting discovery aimed at contradicting those admissions. Where a party would be judicially estopped from contradicting his earlier claims, the evidence that would allow him to contradict those claims cannot possibly be material or essential. *Cf. Volk*, 816 F.2d at 1416. To allow discovery on those subjects would serve no purpose other than to waste the resources of the parties and the Board. *Sweats Fashions*, 833 F.2d at 1567.

Here, Registrant has already admitted in his state court proceeding that the Band operated as a general partnership; that he did not coin the name “Wonderbread 5;” that the Band began using the mark in commerce in 1996; and that when he was terminated from the Band it had no intention of abandoning the mark. *See* Complaint, ¶¶ 11, 24, 25, 91 and Counsel Decl., Ex. A at pp. 48-49. Because he is bound by these admissions, he cannot create a “sham fact issue” by attempting to refute them, and the extensive discovery he seeks on these issues (*see* RFPs 1, 2,

12, 13 and Ints. 2, 3, 6, 8, 11, 12, 13, 14, 15, 16, 19) would serve no purpose other than to delay resolution of this matter. Such dilatory tactics are not permitted by the Rules of Civil Procedure or TBMP Rule 528.06. *See also Sweats Fashions*, 833 F.2d at 1567.

2. Registrant Seeks Discovery on Issues That Are Not Material

Discovery following a motion for summary judgment is appropriate only where the nonmoving party has demonstrated that the evidence he seeks is necessary to create a genuine dispute of material fact. *Keebler*, 866 F.2d at 1389. However, where the evidence sought could not affect the ultimate determination of a fact necessary to the proceedings, the motion for discovery should be denied. *Cf. Anderson*, 477 U.S. at 248.

Registrant seeks discovery on issues that, even if his contentions were proven, would have no bearing on the outcome of Petitioner's motion for judgment. (Recall that Registrant contends that discovery is needed *only* as to whether the Registration must be cancelled due to Petitioner's prior use of an identical mark. Motion at p. 4.) First, he seeks evidence related to whether Petitioner is a general partnership (despite having admitted this fact in the state court action). *See* RFP 12 and Ints. 12-14. He has offered no rationale for how this evidence could affect the disposition of this matter, and neither Petitioner nor the Board is required to speculate as to what legal theories Registrant may eventually wish to assert. *Keebler, supra*, 866 F.2d at 1388 (rejecting post hoc attempts to explain why requested discovery was necessary to oppose motion for summary judgment where reasons were not set forth in motion and affidavit).

Likewise, he seeks discovery as to the creation and selection of the Band name. *See* RFPs 1, 2, 13 and Ints. 2, 11, 15, 16. Even if he had *not* previously admitted that other members of the Band created the name (Complaint, ¶ 24, Pet. Counsel Decl., Ex. A at pp. 48-49), this evidence would not be material to any issue raised in the Petition or the motion for judgment. Merely coining a term does not give rise to ownership rights; rather, ownership derives from the

use of the mark in commerce. *E.g., Combined Oil Indus., Ltd. v. Oil Master, Inc.*, 209 U.S.P.Q. 646 (N.D. Ill.1980). *See also Society Civile v. SA Consortium Vinicole*, 6 U.S.P.Q.2d 1205 (TTAB 1988) (first person or entity to use mark in commerce owns the mark). Because Registrant cannot show that he used the mark other than as a Band member until years after the Band began using it, he had no individual rights to the mark.

Finally, much of the information Registrant requests regarding the minutiae of the Band's use of the mark is immaterial. *See* Ints. 3, 6, 8, 19, 20. Registrant's interrogatories seek, among other things: (1) a detailed description of each and every good and service ever offered by the Band in connection with the mark; (2) the dates that the Band began each identified use; (3) the geographical areas in which the use occurred; (3) the individuals who provided the identified services; (4) a detailed description of the manner in which each use of the mark has been promoted in the United States; (5) who has been responsible for promoting each use from the date of first use to the present. None of this information has any bearing on the issues raised in the Petition or the motion for judgment. Neither in his Answer nor in his Rule 56(f) motion has Registrant ever claimed that the Band abandoned the mark, and he cannot now assert that evidence of the details of the Band's use of the mark is essential. *Keebler, supra*, 866 F.2d at 1388 ("Precience is not a required characteristic of the [TTAB]. Thus the board need not divine all possible afterthoughts of counsel that might be asserted...").

D. Registrant Already Possesses Much of the Information He Claims to Seek Through Discovery

Where, as here, a party already possesses the information he claims to require to oppose a motion for summary judgment, there is no need to delay ruling on the motion for judgment to permit discovery. *Cf. Orion Group*, 12 U.S.P.Q.2d 1923. *See also Sweats Fashions*, 833 F.2d at 1567.

Registrant already has extensive personal knowledge regarding each category of discovery he seeks by virtue of his participation in conversations in which the Band selected its name, his membership in the Band (and therefore his participation in the Band's operation as a general partnership and in the Band's use of the mark), and his role as a party to the only adversarial proceeding relevant to the Petition for Cancellation. For example, in addition to including allegations in his state court Complaint regarding the creation and adoption of the name "Wonderbread 5," Registrant confirmed under oath in his deposition that the allegations in the Complaint regarding the creation of the name were accurate. Counsel Decl., Ex. A at pp. 48-49. He testified that the Band members created the name together and that they began using the name – as a Band, not individually – in 1996. *Id.* Yet Registrant now claims, incredibly, that he cannot effectively oppose Petitioner's motion for judgment without discovery on precisely these issues.

Similarly, Registrant claims entitlement to discovery regarding litigation in which he was the plaintiff. *See* RFPs 6, 7 and Ints. 10, 17, 18. Registrant's Request for Production No. 7 is particularly illustrative of how unnecessary Registrant's discovery requests are. It demands production of a letter that not only was sent to Registrant's attorney in the state court litigation but has also been *filed with the Board in connection with Petitioner's motion for judgment*. *See* Pet. Counsel Decl., Ex. C. As such, Registrant's discovery requests are needless.

In sum, there is no basis for prolonging this litigation by permitting Registrant to conduct unnecessary and dilatory discovery. The Board should order Registrant to promptly file an opposition to Petitioner's motion for judgment, if he intends to oppose the motion, and allow this matter to proceed to resolution.

V. **CONCLUSION**

For all of the reasons set forth above, Petitioner respectfully requests that the Board deny Registrant's Motion for Discovery.

Respectfully submitted,

WONDERBREAD 5

Dated: September 22, 2010

PHILLIPS, ERLEWINE & GIVEN LLP

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CERTIFICATE OF SERVICE

I, Cari A. Cohorn, Esq. Certify that on this 22nd day of September, 2010, a true and correct copy of the foregoing document was filed with the Trademark Trial and Appeal Board via the Electronic System for Trademark Trials and Appeals and was sent by U.S. Mail to:

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 3691948 for the Word Mark WONDERBREAD 5
(Registered on October 6, 2009)

WONDERBREAD 5,

Petitioner,

v.

PATRICK GILLES,

Registrant.

)
)
) Cancellation No. 92052150
)
)
)
)
)
)
)

DECLARATION OF DAVID M. GIVEN IN OPPOSITION TO REGISTRANT'S RULE

56(f) MOTION FOR DISCOVERY

1. I am a partner in the law firm Phillips, Erlewine & Given, LLP, counsel of record for Wonderbread 5 ("Petitioner") in this matter as well as in San Francisco Superior Court Case No. 09-489-573, *Patrick Gilles v. Jeffrey Fletcher et al.* Unless otherwise stated, I have personal knowledge of the facts set forth in this declaration, and, if called to testify as a witness, could and would testify competently thereto.

2. On June 17, 2009, Patrick Gilles ("Registrant") filed a complaint in San Francisco Superior Court against Petitioner, its individual members and its agent and manager. I represented the defendants in that lawsuit.

3. Attached hereto as Exhibit A are true and correct copies of pages 79-80, 144, 147, and 186-87 of Registrant's sworn deposition taken in the above referenced lawsuit.

I declare under penalty of perjury of the laws of the United States of America that the foregoing statements are true and correct.

Dated: September 22, 2010

/s/

David M. Given

EXHIBIT A

1 IN THE SUPERIOR COURT OF THE STATE OF CALIFORNIA

2 IN AND FOR THE COUNTY OF SAN FRANCISCO

3

4

5 PATRICK GILLES, an individual,
on behalf of himself,

6

Plaintiff,

7

vs. No. CGC-09-489573

8

JEFFREY FLETCHER, an
9 individual; JOHN MCDILL, an
individual; THOMAS RICKARD,
10 an individual; MICHAEL TAYLOR,
an individual; JAY SIEGAN, an
11 individual; JAY SIEGAN
PRESENTS, an unknown business
12 entity; and WONDERBREAD 5, a
California general partnership;
13 and DOES 1-10, inclusive,

14 Defendants.

15

Deposition of

16 PATRICK E. GILLES

17 Tuesday, August 11, 2009

18 Volume I

19

20

21 REPORTED BY: CINDY TUGAW, CSR #4805

22

23 NOGARA REPORTING SERVICE
130 Battery Street, Suite 580
24 San Francisco, California 94111
(415) 398-1889

25

1 songs. And it happened very organically.

2 Q. Where did you rehearse?

3 A. I remember rehearsing at 900 Simmons Lane,
4 the first house I owned in Novato where I built a
5 soundproof room in my garage.

6 Q. And how long before the band performed
7 live in front of an audience?

8 A. Very difficult for me to speculate or
9 estimate. I would say within four months. I think
10 our first show was a Thanksgiving in 2006 (sic) at
11 the Faultline.

12 Q. And who came up with the name Wonderbread
13 5?

14 A. That's in the complaint, but I can
15 reiterate it. My recollection was the name -- I
16 presented the name Whitebread 5 -- not 5, Whitebread
17 because it was ironic that we were a Caucasian,
18 Jackson 5 tribute wearing Afros, and I thought the
19 absurdity of it should be self-deprecating and
20 brought out to light.

21 At some point, John McDill, and I'm only
22 speculating, best of my memory, brought the name
23 Wonderbread out. Well, I don't know who to give
24 credit to the number 5 to, but I recall it being
25 associated with the Jackson 5 -- you know, we were

1 really modelling this around the Jackson 5 and their

2 very unique logo of the 5 with a heart around it.

3 So somewhere along the line, and this

4 happened sort of how you mentioned earlier, in a

5 group setting with a lot of ideas being put in, and

6 it happened very organically. So to say where the

7 genesis or credit lies, if that's the goal to find

8 out, I can't tell you. But it was very organic and

9 hard to deconstruct.

10 Q. At that first public performance at the

11 Faultline on Thanksgiving in 1996, were you featured

12 as Wonderbread 5? Was that the name you were using?

13 A. I think so. I recall saying -- I can't

14 imagine we ever went by a different name. I don't

15 recall.

16 Q. Who booked that first show?

17 A. My recollection is Jeff, or through

18 myself. I want to say Jeff made a contact to Robert

19 or Jeff, the other Jeff who owned the Faultline at

20 the time who I was friends with, we'd like to play

21 there. But they had prior knowledge of what I was

22 doing in this Wonderbread 5 because my band was very

23 popular there and made them a lot of money. The

24 Flesh Weapons did very well there. And after the

25 Flesh Weapons broke up, I would attend there and,

1 Q. Anywhere else?

2 A. Yes. I can't recall, but locations before
3 shows, when we had free time. I remember doing
4 something in Los Angeles backstage with my guitar
5 and his laptop.

6 Q. Anywhere else?

7 A. Not that I can recall.

8 Q. Did you have any role other than the
9 actual recording of your part in terms of the
10 production of the backing tracks?

11 A. Yes.

12 Q. What role was that?

13 A. It was what's considered to be mixing,
14 which is level -- choosing the level of the
15 instrument within the groups of the other
16 instruments. And this would happen either onsite
17 during mix or after John would prepare a mix for the
18 band. And he would present it to us and we would
19 get back to him with notes. Rarely did I request
20 changes because John is competent, very competent.

21 Q. Are you aware of any backing tracks that
22 the band is currently using that feature your
23 performance or performances?

24 A. I was instructed not to attend any shows,
25 so I cannot be sure, and I haven't interviewed

1 people to do so. The few videos that I've seen, I

2 do not know.

3 Q. So the answer is no?

4 A. I do not know, yeah. No, I do not know --

5 have not seen the band since.

6 Q. So the answer is no?

7 A. The answer is no. I apologize, I was not

8 trying to be evasive.

9 Q. I understand. You're entitled to answer

10 the way you want. I need to get answers, too.

11 Tell me about how Jay Siegan got involved

12 with Wonderbread 5.

13 A. He learned about us -- this is just my

14 understanding, he learned about the band as we were

15 becoming popular, and saw, I think, great potential

16 in us and also great potential for himself and his

17 growing young company, booking artists, managing

18 artists. I remember meeting with him in San

19 Francisco with the rest of the members.

20 Q. When was that?

21 A. I want to say that it was around -- it's

22 hard for me -- it's in the complaint. I'm guessing

23 it was around '98, may have been as late as 2000. I

24 apologize.

25 Q. And what was discussed at that meeting?

1 MR. GIVEN: Q. I wanted to give the court
2 reporter back her copies of Defendants' Exhibit 2
3 which are the documents that you produced us today,
4 Mr. Gilles, but I wanted to ask you just a couple of
5 questions before I give her back this pile.

6 You have some -- I guess they're
7 screenshots, right, of Wonderbread 5 on YouTube?

8 A. Yes.

9 Q. And just starting with the last one
10 first -- do you have your copy?

11 MR. ADKINS: Our copy is now black and white,
12 but yes.

13 MR. GIVEN: Q. So this is a publicity poster
14 for a show at the Powerhouse Pub?

15 A. Correct.

16 Q. And you have -- this is your handwriting
17 at the bottom?

18 A. Correct.

19 Q. And it says "PG," that's you, right?

20 A. Yes.

21 Q. "Patrick Gilles's, body, guitar, et
22 cetera, bad form"?

23 A. Correct.

24 Q. So what do you mean by that?

25 A. I thought in their letter from Barry Simon

1 happening. Your likeness -- I didn't ask Barry
2 Simon to do that. Barry Simon told me it was. And
3 I guess my words "bad form" is that they're not
4 following with what they said they would do.

5 Q. Well, April 17th, that would have been
6 less than a month after you left the band, right?

7 A. Nope.

8 Q. No?

9 A. March 10th.

10 Q. So about a month after you left the band?

11 A. Correct.

12 Q. And this 19 Broadway show, do you have any
13 idea when that was?

14 A. No. That would be in your client's record
15 of when he generated that poster.

16 Q. We can look that up. Are you currently
17 aware of any other images that the band is currently
18 using that feature your face?

19 A. Yes.

20 Q. And what are those?

21 A. Page prior of that, on the Web site
22 probably as we sit here today, that photograph image
23 and biography is on the Wonderbread 5 Web site.

24 Q. This is the --

25 A. Wonderbread 5 bio.

1 their clothes are made of plastic.

2 Q. How long have you been using them as a
3 band? How long have you been purchasing costumes
4 from them?

5 A. Me personally? I know John and Jeff did
6 it independently for awhile. But I have bought
7 three things from Lip Service that I know of.

8 Q. Over what period of time?

9 A. Two years.

10 Q. So when did you first learn that you had
11 been fired from the band?

12 A. March 10th, unlike Barry's letter that
13 says March 9th. It was actually March 10th around
14 6:00 or 7:00 o'clock at night on a telephone call.

15 Q. And who was the call from?

16 A. Chris Adams.

17 Q. And what did he say to you and what did
18 you say to him in that telephone call?

19 A. His words were "We decided you're out." I
20 think I asked him to repeat it and he said, "We
21 decided you're out."

22 And I said, "You can't do that."

23 And he said, "We did."

24 And I said, "Well, I will be there

25 tomorrow." We had a show the next day. And I said,

1 "I'll be there tomorrow."

2 And he goes, "No, you won't."

3 I said, "I'll be there tomorrow. You
4 can't do this."

5 And then I began to suggest that they
6 reconsider for primarily my benefit that this was
7 just a poorly laid plan that was probably illegal
8 but without compassion, at best.

9 And then he said something like, "Don't
10 embarrass yourself. It's over." And then he hung
11 up briefly. And I wanted to talk to somebody, so
12 that was it.

13 Q. That was the end of the conversation?

14 A. Yeah.

15 Q. Why did you say, "You can't do this"?

16 A. Because I was positive that this was a
17 partnership that required some kind of arrangement,
18 my involvement.

19 Q. I'm not sure I'm following. Was it the
20 agreement of the partnership that everybody would
21 stay together in perpetuity? Is that your
22 understanding of what the band partnership agreement
23 was?

24 A. Until such time that the partnership gets
25 together by the California corporate code and

CERTIFICATE OF SERVICE

I, Cari A. Cohorn, Esq. Certify that on this 22nd day of September, 2010, a true and correct copy of the foregoing document was filed with the Trademark Trial and Appeal Board via the Electronic System for Trademark Trials and Appeals and was sent by U.S. Mail to:

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